



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/728,831

12/01/00

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PM82/0626

EXAMINER

MATECKI, K

ART UNIT

PAPER NUMBER

3653

DATE MAILED:

06/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/728,831

Applicant(s)

BAUMGARTNER ET AL.

Examiner

Katherine Matecki

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/788,801.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Consent of Assignee

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Drawings

The drawings are objected to because figures 3, 4, and 5 should be labeled --PRIOR ART--. Correction is required.

Defective Reissue Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

- 1) The reissue oath/declaration filed with this application fails to comply with 37 CFR 1.63(a)(2) because it does not correctly identify the specification to which it is directed. On line 3 of the first paragraph of the declaration, the patent number should read --5,350,131-- rather than "5,550,361".
- 2) The reissue oath/declaration filed with this application fails to comply with 37 CFR 1.63(a)(3) because it does not identify each inventor's residence, post office address, and country of citizenship. When the reissue is filed by the assignee, the required information

must be present, even if asserted that it is based on the last available information known to assignee.

- 3) The reissue oath/declaration filed with this application fails to comply with 37 CFR 1.63(a)(4) because it does not accurately state whether each inventor is a sole or a joining inventor of the claimed invention. On line 6 of the first paragraph of the declaration it is stated that "said named inventors to be an original, first and sole inventors". Two inventors cannot be sole inventors.
- 4) The reissue oath/declaration filed with this application fails to comply with 37 CFR 1.63(b)(3) because it does not acknowledges the duty to disclose information known to the person to be material to patentability as defined in 37 CFR 1.56.
- 5) The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414. The statement on page 3, second paragraph, of the declaration, that "the error listed above, which is being corrected, up to the time of the filing of this reissue declaration arose without any deceptive intention on the part of the applicant" refers only the the errors specified in the statement provided in the next paragraph, i.e., the incorrect location of the reversing positions and side positions. The statement of lack of deceptive intent as written does not cover the other errors corrected by the amendment filed with the application, such as the change of "midway" to --in a mid-section--.

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Rejection of Claims - Defective Reissue Declaration

Claims 1-6 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office Action.

Allowable Subject Matter

Claims 1-6 would be allowable upon the filing of an acceptable reissue declaration.

Applicant is reminded that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathy Matecki, whose telephone number is (703) 308-2688.

If the examiner cannot be reached, inquiries should be directed to Supervisory Patent Examiner Donald Walsh, whose telephone number is (703) 306-4173.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1113.

The facsimile number for official correspondence related to this application is (703) 305-7687.

Katherine Matecki

KATHERINE MATECKI
PRIMARY EXAMINER
ART UNIT 3653

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June 25, 2001